

## UNITED STATES PATENT AND TRADEMARK OFFICE

APPLN. NO.:	10/615,702	CONFIRMATION NO.:	9739
APPLICANT:	Wayne E. Mock	TC/ART UNIT:	2621
FILED:	July 9, 2003	EXAMINER:	Topgyal, Gelek W.
TITLE:	DVD CONVERSION FOR ON DEMAND		

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In response to the Final Office Action mailed from the U.S. Patent and Trademark Office on April 14, 2009, Applicant requests review of the final rejection in the above-identified application.

This request is being filed with a Notice of Appeal. A three-month extension of time is hereby requested. The Commissioner is hereby authorized to charge any fees which may be required by this paper, and any additional fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 50-2117.

No amendments are being filed with this request. The review is requested for the reasons stated in the remarks below. Claims 1-18 are pending in the application. Applicant respectfully requests reconsideration and allowance of all pending claims, in view of the following remarks.

**Claim Rejections – 35 U.S.C. § 103**

Rejection of Claims 1-6, and 14-18 under 35 U.S.C. § 103(a) as being unpatentable over US 7,139,983 (Kelts) in view of US 5,966,120 (Arazi) and US 6,341,375 (Watkins)

Applicant respectfully traverses the rejection of claims 1-6, and 14-18. Reconsideration is respectfully requested.

Applicant respectfully submits that the combination of Kelts, Arazi, and Watkins does not teach or suggest all the claim limitations as set forth in independent claims 1 and 16. For example, independent claims 1 and 16 recite “[an extractor module for] extracting [the] contents of the DVD into information files and video object files” which is not taught or suggested in the combination of Kelts, Arazi, and Watkins.

The final Office Action states on page 6:

[T]he proposed combination of Kelts and Arazi teaches the claimed as discussed above, however fails to particularly teach that the video on demand or pay per view system utilizes DVDs as the source of the program that is broadcast. In an analogous art, Watkins teaches in col. 3, line 66 through col. 4, lines 16 of the explicit use of DVDs as the source for a video on demand system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to use DVDs as the source of video for VOD systems as taught by Watkins into the proposed combination of Kelts and Arazi to reduce costs for the end users that do not have DVD systems.

Applicant respectfully disagrees with the Office Action's characterization of Watkins in the foregoing statement. Watkins describes manual conversion of the contents of a DVD into a compressed data stream by using a PC server. See Watkins Abstract, FIGS. 2-3 and col. 2, lines 39-44. Applicant notes that the technique of manual conversion of DVD content by a VOD system/server is identified as a problem in the background section of Applicant's specification. See Applicant's specification paragraphs [0009] and [0012]. Additionally, Applicant submits that Watkins fails to describe "extracting the contents of a DVD into information files and video object files." In Watkins, the PC server or the VOD server compresses the content of the DVD into a DVD bitstream. However, there is no description or teaching in Watkins about extracting DVD content into **both** information files (e.g., IFO files) **and** video object files (e.g., VOB files).

Applicant further submits that the combination of Kelts and Arazi also fails to describe "extracting contents of a DVD into information files and video object files" as recited by independent claims 1 and 16, for at least the following reasons:

Kelts is directed to a navigation interface display system generating a navigation element that organizes television programming data in an easy-to-use manner. See Kelts, Abstract. No disclosure of "extracting contents of a DVD into information files and video object files" is present in Kelts. Kelts fails even to describe any automated extraction process which would reorganize DVD files (e.g., .VOB, .IFO, .BUP files) into presentation and navigational data. Kelts merely describes providing navigational information at the display device. Kelts provides no description or teaching about how navigational or other information can be obtained from a DVD.

For at least three reasons, Kelts fails to describe "extracting contents of a DVD into information files and video object files" as recited by independent claims 1 and 16.

Firstly, Kelts nowhere teaches “extracting contents . . . into . . . **video object files**” (emphasis added), as recited by independent claims 1 and 16. In fact, video object files or .VOB files are nowhere even mentioned in Kelts.

Secondly, Kelts also fails to teach “extracting contents . . . into **information files**” (emphasis added), as recited by independent claims 1 and 16. Kelts discloses that programming information is obtained from “individual application databases 606 [that] preferably contain broadcast and programming information such as cable television listings.” Kelts, col. 19, lines 35-37. Assuming, for the sake of argument, that the Examiner has equated the “information files” of the present application to the “individual application databases” of Kelts, Applicant points out that Kelts nowhere discloses any system or method for **extracting** these “individual application databases” from any other content. To the contrary, Kelts teaches that “the individual content providers and service providers will be responsible for updating and maintaining the data stored in application databases 606.” Kelts, col. 19, lines 52-54. Thus, Kelts does not disclose “extracting contents . . . into information files” as recited by independent claims 1 and 16.

Finally, Kelts fails to teach “extracting contents **of the DVD**” (emphasis added). The final Office Action on page 5 states “information files from the ‘selection items’ can inherently be from any source, e.g. DVDs... The video used for the VOD or PPV program can inherently be from any source, e.g. DVDs.” Applicant respectfully disagrees with the statement. The MPEP states, “[I]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP 2112 (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). The Office Action does not describe how it is obvious for a person having ordinary skill in the art to extract contents of a DVD into information files based on the teachings from Kelts. The Examiner cites column 8, lines 18-40 of Kelts for this feature. The cited portion of Kelts merely describes that the display selection items may represent various types of data or information such as broadcast information, radio programs, pay per view programs, video on demand programs, locally recorded videos, and any combination thereof. See Kelts col. 8, lines 35-40. The Examiner characterizes this teaching of Kelts by noting, at page 2 of the Office Action, “The selection items being typical movies/programs that can be [] ordered via VOD or PPV.” Applicant agrees

with the Examiner that Kelts is directed to the “typical” programs enumerated at col. 8, lines 35-40 of Kelts. Applicant further points out that the list of items at col. 8, lines 35-40, is closed, not open-ended, because Kelts includes no broadening language (language such as “e.g.,” “such as,” “for example,” “et cetera,” “comprising,” “and the like”) in the list. Thus, the disclosure of Kelts is limited to the examples disclosed, which do not include DVDs.

Applicant points out that Kelts has omitted DVDs from this list of items, and submits that the omission in Kelts is intentional. Kelts discloses that programming information is obtained from “individual application databases 606 [that] preferably contain broadcast and programming information such as cable television listings.” Kelts, col. 19, lines 35-37. Kelts specifically teaches, “In a **practical** system, the individual content providers and service providers will be responsible for updating and maintaining the data stored in application databases 606.” Kelts, col. 19, lines 52-54 (emphasis added).

In view of the foregoing, Applicant submits that the combination of Kelts, Arazi, and Watkins fails to describe extracting contents of a DVD into information files and video object files as recited by independent claims 1 and 16. Since, all the claim elements of independent claims 1 and 16 are not taught or suggested by the combination of Kelts, Arazi, and Watkins, independent claims 1 and 16 are not obvious in view of the combination of Kelts, Arazi, and Watkins, and therefore that the rejection of independent claims 1 and 16 under 35 U.S.C. § 103(a) should be withdrawn. Applicant requests that independent claims 1 and 16 now be passed to allowance.

### Teaching Away

Applicant respectfully submits that Kelts fails to provide a basis for a rejection under 35 U.S.C. § 103, at least because Kelts expressly **teaches away** from “extracting contents of a DVD into information files and video object files” as recited by independent claims 1 and 16.

Kelts **teaches away** from extracting information stored in DVDs. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). Kelts teaches away from the use of programming data stored in DVDs, at least because DVDs typically contain read-only

data that cannot be updated or maintained by a content provider or service provider. Kelts teaches that “updating and maintaining the data” results in “a **practical** system” (*id.*); accordingly, a person of ordinary skill reading Kelts would logically conclude that “extracting contents of a DVD” – contents that cannot be updated or maintained – would result in an **impractical** system. Accordingly, a person of ordinary skill, upon reading the Kelts reference, would be led in a direction divergent from the path that was taken by the Applicant.

Applicant respectfully submits that Kelts fails to provide a basis for a rejection under 35 U.S.C. § 103, at least because Kelts expressly **teaches away** from “extracting contents of a DVD into information files and video object files” as recited by independent claims 1 and 16. Because Kelts is an **improper basis** for rejecting Applicant’s claims, the combination of Kelts with Arazi, or with other prior art references, is also an improper basis for rejecting Applicant’s claims. Accordingly, Kelts should be disqualified as a reference under 35 U.S.C. § 103(a).

Dependent claims 2-6, 14-15, and 17-18 depend from and include all the limitations of independent claims 1 and 16. Therefore, Applicant respectfully requests the reconsideration of dependent claims 2-6, 14-15, and 17-18 and requests withdrawal of the rejection.

### **Conclusion**

Claims not specifically mentioned above are allowable at least due to their dependence on an allowable base claim.

In light of the arguments presented above, it is respectfully submitted that all pending claims are in condition for allowance. Reconsideration and withdrawal of the final rejection of the claimed invention is respectfully requested.

Respectfully submitted,

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